

## **Remarks**

### **Restriction Requirement**

The Office has made the restriction requirement final even though applicants' previous traversal was found persuasive. Applicants respectfully request reconsideration. In this context, applicants would also like to point out that claim 1, whose content appears to have been the basis for maintaining the restriction requirement has been cancelled.

Applicants, however, reserve the right to file divisional application(s) directed to the withdrawn subject matter.

### **Drawings**

The drawings have been objected to because it was said that there is no brief description of the figures in the specification. Applicants would like to direct the Office's attention to the brief description added in the preliminary amendment of May 6, 2005 (page 2 of the amendment). However, to ensure completeness of this response, applicants have here again directed introduction of the respective amendments to the specification. If the Office considers these amendments to the specification duplicative, authorization to cancel the amendments to the specification presented herein is given and cancellation is indeed respectfully requested. Since only the lack of a brief description of the drawings was objected to, no new sheets or replacement sheets are submitted herewith.

### **Enablement**

On pages 3 to 5, the Office rejected claim 1 as being not enabled under 35 USC §112, first paragraph.

For the sole purpose of advancing the prosecution of this case, claim 1 has been cancelled. Accordingly, this rejection is considered moot.

**Definiteness**

On pages 5 and 6, the Office rejected claim 1 and 11 as indefinite under 35 USC §112, second paragraph.

Applicants note, that the highest U.S. Patent Court, the CAFC, has repeatedly stated, including in June of last year (*Young v. Lumenis*, 06-1455, Fed. Cir., June 27, 2007), that claims are indefinite only when they are “not amenable to construction or are insolubly ambiguous.” Also, the CAFC made clear that examination of any intrinsic evidence is required in an indefiniteness determination (See also, *Praxair v. ATMI*, 07-1483, -1509, Fed. Cir. Sep. 29, 2008, where the court specifically referenced the specification).

Similarly, the Manual of Patent Examining Procedure (MPEP) clarifies that all that is required for a particular phrase to be definite is a reasonable degree of clarity and particularity. The MPEP also emphasizes that the definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by those possessing the ordinary level of skill in the pertinent art at the time the invention was made (MPEP §2173.02). The MPEP refers to *Metabolite Labs.* in which the CAFC stated that only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite. *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366 (Fed. Cir. 2004).

Applicant submits that the present claims, in particular, when viewed in conjunction with the disclosure, readily meet the threshold requirement of clarity and particularity.

For the sole purpose of advancing the prosecution of this case, claim 1 has been cancelled. Accordingly, the indefiniteness rejection with regard to claim 1 is considered moot.

With regard to claim 11, the Office further expressed the opinion that the exact step to attach a radiolabelled compound to a compound of claim 1 has been omitted, but that this step is an essential step.

Applicants note that in b), the bioactive molecule is coupled to the free carboxylate group and in d) the obtained chelator is labeled with the desired radio metal. Applicants would in this context like to direct the Office to the disclosure, in particular to page 4, lines 16 to 24, and respectfully submit that there appears to be no essential step that has been omitted. However, antecedent basis issues have been addressed.

Applicants respectfully submit that the invention as claimed thus readily meets the threshold requirement of clarity and particularity. In particular, claim 11 apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph (MPEP §2173.02).

### **Anticipation**

On page 6, the Office rejected claim 1 as anticipated under 35 USC §102(a) by Heppler. In particular, Heppler was said to teach compound 5, which is said to anticipate a compound encompassed by claim 1.

For the sole purpose of advancing the prosecution of this case, claim 1 has been cancelled. Accordingly, this rejection is considered moot.

### **New Claim**

Support for new claim 19 can be found, e.g., in original claim 11.

### **Conclusion**

Applicants respectfully submit that all issues raised in the Office Action of July 1, 2008 have been fully addressed. In particular, claims 2 and 3, which were said to contain allowable subject matter, have been rewritten to include all of the limitations of the base claim and any intervening claims. The indefiniteness rejections with regard to claim 11

has been addressed. New claim 19 depends on claim 2. Thus, all pending claims should now be in condition for allowance and an early issuance of a notice of allowance is respectfully requested.

If the Office believes that any further issue needs to be addressed, the Office is urged to call the undersigned at the number provided below for a speedy resolution of any such issues.

No additional fees are believed to be due. However, the Office is authorized to charge any underpayment or deposit any overpayment to deposit account 50-3135.

Respectfully submitted,

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